

REMARKS

Reconsideration is respectfully requested.

DRAWINGS - 37 CFR 1.83(a)

The Examiner's objection to the drawings based on 37 CFR 1.83(a) is improper.

In reference to FIG. 3, Applicant's specification states (beginning on page 22, line 21):

"Preferably, frame 105 comprises a second side 138 having a roof-shaped portion 140, as shown. Roof-shaped portion 140 is preferably adapted to aid the user in distinguishing the function of slope determination tool 100, as shown (embodying herein an inclinometer calibrated to measure slope comprising at least one representation of at least one roof to indicate that the inclinometer is calibrated for measuring roof slope)".

FIG. 3 clearly identifies the chevron-shaped periphery as roof-shaped portion (140). Since the roof representation of claim 42 is shown, no corrected drawings should be necessary. Applicant respectfully requests that Examiner's rejection with respect to 37 CFR 1.83(a) be withdrawn.

Furthermore, the Applicant has noted that this Office Action was not accompanied by a "Notice of Draftsperson's Patent Drawing Review" (PTO-948), and form PTO-326 made no indication that such Notice was forthcoming. Applicant therefore requests that the drawings in this case be accepted by the Examiner as originally filed.

35 USC §102

The Examiner has rejected Claims 1-3, 5, 7, 13, 15-23, 26-28, 31, 34, 36, and 38 under 35 USC §102, as allegedly being anticipated by Hamernick (US 1,919,106).

Applicant has amended Claims 1-2', 6-14, 31, and 34 to even more clearly distinguish applicant's invention from the prior art references.

The courts have ruled that "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Also, "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Regarding Claim 1 and Claim 2, Applicant respectfully submits that the Hamernick reference does not teach each and every element of Applicant's currently amended claims. Specifically, the Hamernick reference does not teach a protective cover means for protectively covering a multiple-indicator means, nor a protective cover means which comprises calibrated indicia means, nor calibrated indicia means which designate slope defined by a measure of vertical rise over a measure of horizontal run, as per Applicant's amended Claim 1. Similarly, Hamernick does not teach a protective cover adapted to protectively cover a multiple-indicator, wherein said cover comprises a transparent portion and said protective cover comprises calibrated indicia wherein such calibrated indicia designates slope defined by a measure of vertical rise over a measure of horizontal run as per Applicant's amended Claim 2.

Hamernick teaches, "*the reference numeral (5) designates a protractor disk having an angle degree indicia (6)*". Hamernick is incapable of providing direct readings of slope defined by a measure of vertical rise over a measure of horizontal run, as does Applicant. Hamernick clearly lacks the inherent function of Applicant's device. Moreover, the teachings of Hamernick fail to

provide any indication or suggestion of a motivation to provide other than angle degree scale of Hamernick's protractor.

It is therefore respectfully submitted that the Hamernick reference does not anticipate Applicant's Claim 1 and Claim 2 and respectfully requests that rejection of Claims 1 and 2 (and all Claims dependent therefrom) should be withdrawn.

Regarding Claim 3, Claim 3 depends from Claim 2. Applicant believes Claim 2 should be allowable and therefore Claim 3 should be allowable.

Regarding Claim 5 and Claim 21, Applicant submits that the Hamernick reference does not show nor enable "wherein at least one scale portion of said at least one first calibrated scale is viewable from a position above said slope determination system" or "wherein said at least one first pointer portion is viewable from a position above said slope determination system" as per Claim 5 and Claim 21 respectively. Applicant clearly teaches (page 38, lines 13-17 of the specification), *"Top-view is understood to mean that a user looking downward onto the slope determination tool 222 can read the calibrated scale 230. Most preferably, top-view is further understood to mean that any portion of the entire viewable peripheral arc 200 of top-readable gauge 224 may be read"*. The Examiner's contention that Hamernick discloses a scale viewable from the top is erroneous. Hamernick states that protractor disk (5) is mounted within bar (16) to be viewable "from either side of the level strip or bar (16)". Both the thinness of the protractor disk (5) and its internal positioning with opaque bar (16) make it impossible for a user to view or read the indicia of protractor disk (5) in any position other than a side view. The Hamernick reference does not show nor enable a scale viewable from above, as does Applicant. Thus, it is respectfully submitted that the scale of the Hamernick device is NOT viewable from above, that the Examiner has failed to establish a prima facie case of anticipation and that rejection of Claim 5 (and all Claims dependent therefrom) and Claim 21 (and all Claims dependent therefrom) should be withdrawn.

With respect to Claim 7, the Hamernick reference does not show nor enable *"wherein at least one portion of said at least one calibrated scale is printed on at least one replaceable dial"*. Hamernick teaches that protractor disk (5) is permanently blocked from removal by flange (20) secured to bar (16) using nails (21). Thus, it is respectfully submitted that Examiner has failed to establish a prima facie case of anticipation and that rejection of Claim 7 (and all Claims dependent therefrom) should be withdrawn.

Regarding Claim 18, Claim 19, Claim 22, and Claim 26, the aforementioned Claims depend from Claim 2. Applicant believes Claim 2 should be allowable and therefore Claim 18 and Claim 19, Claim 18, Claim 19, Claim 22, and Claim 26 should be allowable.

Regarding Claim 13, and Claim 15 through Claim 17, the aforementioned Claims depend from Claim 3. Applicant believes Claim 3 should be allowable and therefore Claim 13, Claim 15, Claim 16, and Claim 17 should be allowable.

Regarding Claim 20, Claim 20 depends from Claim 19. Applicant believes Claim 19 should be allowable and therefore Claim 20 should be allowable.

Regarding Claim 27, and Claim 31, Claim 27, and Claim 31 depend from Claim 26. Applicant believes Claim 26 should be allowable and therefore Claim 27 and Claim 31 should be allowable.

Regarding Claim 34, Claim 34 depends from Claim 31. Applicant believes Claim 31 should be allowable and therefore Claim 34 should be allowable.

Regarding Claim 23, Applicant submits that the Hamernick reference does not teach nor enable *"wherein said at least one gravity-assisted positioner comprises at least one rotatable gauge comprising at least one rotatable scale mounted in said at least one substantially rigid frame"*. Hamernick does not teach that the rotatable indicator arm (12) or plumb bob (13) comprise a gauge with a scale or other form of calibrated indicia. It is therefore respectfully submitted that

rejection of Claim 23 (and all Claims dependent therefrom) should be withdrawn.

With respect to Claim 28, the Hamernick reference does not show nor enable a rigid metal angle, as does Applicant. Applicant states on page 25, in reference to FIG. 4, "*Preferably, face 107 comprises a continuous rigid metal angle 123 (embodying herein wherein such at least one abutter further comprises an angled rigid metal bar), preferably aluminum, preferably adapted to provide a flat and durable surface along the entire length of face 107, as shown*". Applicant enables a separate metal element (angle 123) applied to face 107 for durability. Based on Examiner's comments, it is unclear if Examiner understood the term "angle" as commonly used in the art to denote a metal element rolled or extruded to comprise an essentially L-shaped section. The Hamernick reference does not show nor enable a separate metal element (angle or otherwise) applied to the frame, as does Applicant. Applicant's selection of metal as the preferred material of construction was critical to Applicant's qualification of durability. Applicant's use of an applied metal angle has distinct advantages over Hamernick in terms of durability during service. Thus, it is respectfully submitted that Examiner has failed to establish a prima facie case of anticipation and that rejection of Claim 28 should be withdrawn.

With respect to Claim 36, the Hamernick reference does not show nor enable a protective cover and therefore could not have enabled a cover replaceable by the user. Thus, it is respectfully submitted that rejection of Claim 36 should be withdrawn.

Regarding Claim 38, Applicant submits that the Hamernick reference does not teach or enable a grip assister adapted to assist a user in gripping. Hamernick does not show or describe the presence of any adaptation designed to assist the user in holding or gripping the Hamernick device. It is therefore respectfully submitted that Examiner has failed to establish a prima facie case of anticipation and that rejection of Claim 38 and should be withdrawn.

The Examiner has rejected Claims 1-3, 5, 6, 10, 11, 13, 15-23, 26-28, 31, 34, 36, 38, and 39 under 35 USC §102, as allegedly being anticipated by Bateman (US 2,847,765).

Applicant has amended Claims 1-2, 6-14, 23, 31, and 34 to more clearly distinguish applicant's invention from the prior art references.

Regarding Claim 1 and Claim 2, as amended, Applicant respectfully submits that the Examiner has failed to establish a prima facie case of anticipation under 35 USC §102 since the Bateman reference does not teach each and every element of Applicant's currently amended claims. Specifically, the Bateman reference does not teach a protective cover comprising calibrated indicia. Bateman teaches "coaxial disks (44) and (46) which are transparent for reading therethrough" containing no indicia. The advantages of Applicant's arrangements over Bateman are as described for Hamernick, hereinabove. Applicant repeats as though fully set forth here the above arguments. It is therefore respectfully submitted that the Hamernick reference does not anticipate Applicant's Claims and that rejection of Claims 1 and 2 (and all Claims dependent therefrom) should be withdrawn.

Regarding Claim 5 and Claim 21, Applicant submits that the Bateman reference does not show nor enable "*wherein at least one scale portion of said at least one first calibrated scale is viewable from a position above said slope determination system*" or "*wherein said at least one first pointer portion is viewable from a position above said slope determination system*" as per Claim 5 and Claim 21 respectively. Reiterating Applicant's teachings on page 38 of the specification, "*Top-view is understood to mean that a user looking downward onto the slope determination tool 222 can read the calibrated scale 230. Most preferably, top-view is further understood to mean that any portion of the entire viewable peripheral arc 200 of top-readable gauge 224 may be read*". The Examiner's contention that Bateman discloses a scale viewable from the top is incorrect. Bateman teaches that scale (62) and scale (64) are disposed within circular opening (40). Clearly, it is impossible for a user to view or read scale (62) or scale (64) in any position other than a side view, given that Bateman has located the scales within the circular opening (40) of frame (10). The Bateman reference does not show nor enable a scale viewable from above, as does Applicant. Thus, it is respectfully submitted that Examiner has failed to establish a prima facie case of anticipation and that rejection of Claim 5 and Claim 21 should be withdrawn.

Regarding Applicant's Claim 10, the Bateman device does not provide calibrated indicia indicting **at least one rise over at least one run**. Bateman teaches, "...a scale (62), graduated in degrees and a scale (64) graduated in inches per foot rise" as applicable in work related to pipe layout. Bateman's measurement in "inches per foot rise" is **not** equivalent to Applicant's rise over run measurement, applicable in the direct determination of roof pitch. Clearly, one-inch of rise in one-foot of run is not equivalent to one-inch of run in one-foot of rise. It is therefore respectfully submitted that Examiner has failed to establish a prima facie case of anticipation and that rejection of Claim 10 (and all Claims dependent therefrom) should be withdrawn.

Regarding Applicant's Claim 11, Applicant notes that the Bateman device does not provide an indication of a "rise/run of 12 inches" as suggested by the Examiner. Bateman describes, "...a scale (62), graduated in degrees and a scale (64) graduated in inches per foot rise" as applicable in work related to pipe layout. The current method of measuring the pitch of a roof involves using a measuring device and a spirit level. The Bateman referenced states that the tool being described would replace the spirit level only. The Bateman device alone could not replace Applicant's system, as the Bateman device **does not** include calibrated indicia indicating distance of rise, in inches, over 12-inches of run, as applicable in the direct determination of roof pitch. FIG. 2 of Bateman clearly shows a scale that is not suited for measuring inches of rise over 12-inches of run. FIG. 2 of Bateman clearly illustrates that the number "12" on inner scale (64) is aligned at the 90 degree to level marking on outer scale (62). A scale indicating a 12-inch rise in a 12-inch run would position the number 12 at the 45-degree mark, **not at the 90-degree** mark as shown in Bateman. No indicia of the Bateman embodiment, is equivalent to Applicant's preferred indication of inches of rise over a run of 12 inches. It is therefore respectfully submitted that Examiner has failed to establish a prima facie case of anticipation and that rejection of Claim 11 (and all Claims dependent therefrom) should be withdrawn.

Regarding Claim 13, and Claims 15 through 17, Claim 13 and Claim 15 through 17 depend from Claim 3. Applicant believes Claim 3 should be allowable and therefore Claim 13 and Claims 15

through 17 should be allowable.

Regarding Claim 18, Claim 19, Claim 22, and Claim 26, the aforementioned Claims depend from Claim 2. Applicant believes Claim 2 should be allowable and therefore Claim 18, Claim 19, Claim 22, and Claim 26 should be allowable.

Regarding Claim 20, Claim 20 depends from Claim 19. Applicant believes Claim 19 should be allowable and therefore Claim 20 should be allowable.

Regarding Claim 27 and Claim 31, Claim 27 and Claim 31 depend from Claim 26. Applicant believes Claim 26 should be allowable and therefore Claim 27 and Claim 31 should be allowable.

Regarding Claim 23, Applicant submits that the Bateman reference does not teach or enable *"wherein said at least one gravity-assisted positioner comprises at least one rotatable gauge comprising at least one rotatable scale mounted in said at least one substantially rigid frame"*. Bateman does not teach that rotatable indicator (86) comprises a gauge with a scale or other form of calibrated indicia. It is therefore respectfully submitted that Examiner has failed to establish a prima facie case of anticipation and that rejection of Claim 23 should be withdrawn.

With respect to Claim 28, the Bateman reference does not show nor enable a rigid metal angle, as does Applicant. Applicant states on page 25, in reference to FIG. 4, *"Preferably, face 107 comprises a continuous rigid metal angle 123 (embodying herein wherein such at least one abutter further comprises an angled rigid metal bar), preferably aluminum, preferably adapted to provide a flat and durable surface along the entire length of face 107, as shown"*. Applicant enables a separate metal element (angle 123) applied to face 107 for durability. Applicant again notes that the term "angle" is commonly used in the art to denote a metal element rolled or extruded to comprise an essentially L-shaped section. The Bateman reference does not show nor enable a separate metal element (angle or otherwise) applied to the frame, as does Applicant. Applicant's selection of metal as the preferred material of construction was critical to

Applicant's qualification of durability. Applicant's use of an applied metal angle has distinct advantages over Bateman in terms of durability during service. Thus, it is respectfully submitted that Examiner has failed to establish a prima facie case of anticipation and that rejection of Claim 28 should be withdrawn.

Regarding Claim 34, Claim 34 depends from Claim 31. Applicant believes Claim 31 should be allowable and therefore Claim 34 should be allowable.

Regarding Claim 36, Applicant submits that the Bateman reference does not teach or enable at least one protective cover replaceable by a user. Bateman teaches that coaxial disks (44) and (46) are maintained the tool by means of plaster of Paris. Destructive removal of the plaster of Paris is required to remove disks (44) and (46) from frame (10). Therefore, disks (44) and (46) cannot be considered "removable" by any reasonable definition. Thus, it is respectfully submitted that Examiner has failed to establish a prima facie case of anticipation and that rejection of Claim 36 should be withdrawn.

Regarding Claim 38 and Claim 39, Applicant submits that the Bateman reference does not teach or enable a grip assister adapted to assist a user in gripping. Bateman does not show or describe the presence of any purposeful element designed to assist the user in holding or gripping the Bateman device. No indication is given as to the size, shape, or suitability for gripping of apertures (if any) located within frame (10) of Bateman. It is therefore respectfully submitted that Examiner has failed to establish a prima facie case of anticipation and that rejection of Claim 38 and Claim 39 should be withdrawn.

Applicant believes that all Claims, as amended, are now allowable with respect to 35 USC §102 and respectfully request that all such rejections be withdrawn.

35 USC §103

The Examiner has rejected Claims 4, 8, 9, 29, 32, 33, 35, 37, 40, and 42 under 35 USC §103, as allegedly being unpatentable over Hamernick (US 1,919,106).

Applicant has amended Claims 1-2, 6-14, 31, and 34 to more clearly distinguish applicant's invention from the prior art references.

Applicant repeats in full at this point by reference the entire above argument regarding the Hamernick reference and submits that Hamernick is *not* a proper primary reference in that, as pointed out above, the Hamernick device has a different arrangement and works in a different way than does Applicant's device. For this reason, it is respectfully submitted that Examiner has not made a prima facie case of obviousness and that rejection of Claims 4, 8, 9, 29, 32, 33, 35, 37, 40, and 42 should be withdrawn.

The Federal Circuit has enunciated several guidelines in making a §103 obviousness determination. A prima facie case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed Cir. 1993) (quoting *In re Rinehart*, 531 F.2d 1048, 1051 (CCPA 1976)). (Emphasis added). For the Examiner to establish a prima facie case of obviousness, the Examiner must contend that the teachings from the prior art *itself* or that knowledge generally available to one of ordinary skill in the art would appear to suggest the claimed subject matter to a person of ordinary skill in the art.

It is well settled that to support an obviousness rejection, the prior art must contain some teaching or suggestion to make the modifications suggested by the Examiner. In this regard, the Federal Circuit has stated that "The mere fact that the prior art **may** be modified in the manner suggested by the Examiner does **not** make the modification obvious unless the prior art suggested the desirability of the modification." (emphasis added) *In re Fritch*, 23 USPQ 2d 1780, 1783-84 (Fed. Cir. 1992.) Applicant respectfully submits that no such suggestion exists in

the Hamernick reference to so modify the elements to result in the Applicant's claimed invention.

Applicant repeats in full at this point by reference the entire above arguments regarding the Hamernick reference.

With respect to Claim 4, Examiner has clearly affirmed in his own statement one aspect of the criticality of Applicant's size of diameter preference "*to provide a scale with the desired accuracy*". Applicant's preference for size of scale indicia, to improve accuracy of slope determination, is important to the accuracy of Applicant's device and therefore constitutes a patentably distinct feature.

It is Examiner's apparent position that Applicant's dimensional preference to improve accuracy would have been obvious to a person of ordinary skill in the art yet Examiner has not produced a single pertinent reference supporting this position. The Hamernick reference itself provides **no teaching or suggestion** as to increasing the size of protractor disk (5) or degree indicia (6), or any other element of the device, to achieve a greater accuracy. The Examiner's position that modification of size to improve accuracy is obvious is a mere *ipse dixit* of the Examiner; and if the Examiner persists with this position, Applicant respectfully requests that the Examiner submit an Affidavit to that effect. Applicant respectfully submits that the Examiner has not made a prima facie case of obviousness for the element of this Claim. It is therefore respectfully submitted that rejection of Claim 4 should be withdrawn.

With respect to Claims 1, 2, and 8, Applicant has amended Claims 1, 2, and 8 to more clearly distinguish applicant's invention from the prior art references. Hamernick does not contain a protective cover, nor does Hamernick provide teaching or suggestion as to providing a protective cover. As the Hamernick reference does not contain a protective cover, it could not have been obvious to relocate the degree indicia (6) from protractor disk (5) to such protective cover, as suggested by Examiner.

Applicant's intent, as clearly stated in Applicant's teachings, is to provide a slope determination system providing *"direct readings of the slope measurement"* and *"a system that is accurate within one-half of a degree"*. Applicant's stated preference for placement of the calibrated indicia on the protective cover is important to the user's ability to achieve Applicant's stated accuracy of measurement. Applying such calibrated indicia to the protective cover (in front of the pointer) greatly improves the accuracy of scale readings by permitting a user to make direct readings of scale indicia without visual hindrance (that is, no portion of the scale indicia is blocked or obscured by the pointer). Therefore, Applicant's stated preference for the location of scale indicia, to improve accuracy of slope determination, meets the criticality criteria and therefore constitutes a patentably distinct feature.

Applicant respectfully submits that the Examiner has not made a prima facie case of obviousness for the elements of Claim 8 and that rejection of Claim 8 should be withdrawn.

Regarding Claim 9, as amended, Hamernick does not contain a protective cover, nor does Hamernick provide a teaching or suggestion as to providing a protective cover. As the Hamernick reference does not contain or suggest a protective cover, discussion of Applicant's additional limiting features is moot. It is therefore respectfully submitted that Examiner has not made a prima facie case of obviousness and that rejection of Claim 9 should be withdrawn.

Regarding Claim 29, Applicant teaches (page 17, lines 5-11 of the specification), in reference to FIG. 1, *"Roof 102 is shown sheathed with shingles 104 having a tapered cross sectional profile...The preferred extended length of face 107 permits slope determination tool 100 to simultaneously rest over a number of shingles 104, thereby preferably permitting slope determination tool 100 to closely conform to the slope of the underlying substrate, as show"*. Applicant's preference for face 107 comprising a length of about 24 inches is important to the function of Applicant's device, as stated above and therefore meets the criticality criteria. It is clearly improper for Examiner to reject Claim 29 due to a lack of criticality based on size. Moreover, it is well known within the art of pipeline branch layout work, that pipes generally comprise essentially smooth, unitary, exterior shapes. As such, it would not have been obvious

to one of ordinary skill in the art to modify Bateman to span an irregular surface or closely conform to the slope of an underlying substrate. Since Examiner offers no additional basis for the rejection of Claim 29, Applicant respectfully submits that Examiner has not made a prima facie case of obviousness and that rejection of Claim 29 should be withdrawn. Furthermore, Claim 29 depends from Claim 2 (Claim 27 and Claim 26). Applicant believes Claim 2 should be allowable and therefore Claim 29 should be allowable.

Regarding Claim 32, Claim 32 depends from Claim 2 (Claim 31 and Claim 26). Applicant believes Claim 2 should be allowable and therefore Claim 32 should be allowable.

Regarding Claim 33, Claim 33 depends from Claim 2 (Claim 31 and Claim 26). Applicant believes Claim 2 should be allowable and therefore Claim 33 should be allowable.

Regarding Claim 35, Applicant repeats in full at this point by reference the entire above argument regarding amended Claim 1 and Claim 2 with specific regard to Examiner's rejection of Applicant's original Claim 8. Hamernick does not contain a protective cover, nor does Hamernick provide teaching or suggestion as to providing a protective cover. As the Hamernick reference does not contain a protective cover, it could not have been obvious to relocate the degree indicia (6) from protractor disk (5), as suggested by Examiner. It is therefore respectfully submitted that Examiner has not made a prima facie case of obviousness and that rejection of Claim 35 should be withdrawn.

Regarding Claim 37, Applicant repeats in full at this point by reference the entire above arguments to Claim 4 regarding Applicant's preferred scale size to improve accuracy. Applicant again submits that such a limitation is non-obvious, and that there has not been presented a prima facie case of obviousness. It is therefore respectfully submitted that rejection of Claim 37 should be withdrawn.

Regarding Claim 40, Applicant repeats in full at this point by reference the entire above argument regarding Claim 29 and Applicant's length preference to permit measurement of pitch over an irregular surface. Applicant again submits that such a limitation is non-obvious, and that

there has not been presented a prima facie case of obviousness. It is therefore respectfully submitted that rejection of Claim 40 should be withdrawn.

Regarding Claim 42, Applicant states on page 22 in reference to FIG. 3, "*Preferably, frame 105 comprises a second side 138 having a roof-shaped portion 140, as shown. Roof-shaped portion 140 is preferably adapted to aid the user in distinguishing the function of slope determination tool 100, as shown*". The chevron peripheral shape selected by the Applicant is especially useful in conveying the essential function of the apparatus to a user by visual and tactile means. None of the cited references, including Hamernick, teach or suggest the use of identifying indicia, to assist the user in identifying the function of the device. Clearly, none of the cited references, including Hamernick, teach or suggest a roof-shaped peripheral structure adapted to assist the user in identifying the function of the device. Furthermore, the structure and tactile function of Applicant's Roof-shaped portion 140 is distinctly different from any "... printed matter such as a logos, text, or shapes", suggested by Examiner. Applicant respectfully submits that the Examiner has not made a prima facie case of obviousness for the element of this Claim. It is therefore respectfully submitted that rejection of Claim 42 should be withdrawn.

The Examiner has rejected Claims 4, 8, 9, 12, 29, 32, 33, 35, 37, 40, and 42 under 35 USC §103, as allegedly being unpatentable over Bateman (US 2,847,765).

Applicant has amended Claims 1-2, 6-14, 31, and 34 to more clearly distinguish applicant's invention from the prior art references.

Applicant repeats in full at this point by reference the entire above argument regarding the Bateman reference and submits that Bateman is *not* a proper primary reference in that, as pointed out above, the Bateman device has a different arrangement and works in a different way than does Applicant's device. For this reason, it is respectfully submitted that rejection of Claims 4, 8, 9, 12, 29, 32, 33, 35, 37, 40, and 42 should be withdrawn.

With respect to Claim 4, Applicant's preference for size of scale indicia, to improve accuracy of slope determination, is important to the preferred accuracy of Applicant's device and therefore meets the criticality criteria and constitutes a patentably distinct feature.

The Bateman reference itself provides **no teaching or suggestion** as to increasing the size of scale (62), scale (64), or any other element of the device, to achieve a greater accuracy. Again, the Examiner's position that modification of size to improve accuracy is obvious is a mere *ipse dixit* of the Examiner; and if the Examiner persists with this position, Applicant respectfully requests that the Examiner submit an Affidavit to that effect. Applicant respectfully submits that the Examiner has not made a prima facie case of obviousness for the element of this Claim. It is therefore respectfully submitted that rejection of Claim 4 should be withdrawn.

In reference to Claim 1, Claim 2 and Claim 8, Bateman does not provide a teaching or suggestion as to the relocating of scale (62) and/or scale (64) to disk (44) and/or disk (46).

Applicant respectfully submits that the Examiner has not made a prima facie case of obviousness for the element of this Claim. It is therefore respectfully submitted that rejection of the limitation of the original Claim 8 (currently the limitation of Claim 1 and Claim 2 as amended) should be withdrawn.

Regarding Claim 9, as amended, Bateman does not provide a teaching or suggestion as to making coaxial disks (44) and (46) removable from frame (10). Furthermore, Bateman does not provide a teaching or suggestion as to making **any** portion of the Bateman device removable or replaceable. It is therefore respectfully submitted that Examiner has not made a prima facie case of obviousness and that rejection of Claim 9 should be withdrawn.

Regarding Claim 12, as amended, Bateman does not provide a teaching or suggestion as to providing calibrated indicia designating at least one slope having a run of one-eighth-inch and a rise of twelve-inches. As illustrated, the ability to make a direct and reliable measurement of one-eighth-inch and a rise of twelve-inches is not within the accuracy of the Bateman device.

Therefore, it would not have been obvious for a person of ordinary skill in the art to provide such a marking. Furthermore, it not clear that such a direct measurement has any useful applicability within the art of pipeline branch layout work. It is therefore respectfully submitted that Examiner has not made a prima facie case of obviousness and that rejection of Claim 12 should be withdrawn.

Regarding Claim 14, as amended, Bateman does not provide a teaching or suggestion as to providing calibrated indicia designating at least one slope defined by percent of slope. It not clear that such a direct measurement has any useful applicability within the art of pipeline branch layout work. Therefore, it would not have been obvious for a person of ordinary skill in the art to provide such a marking. It is therefore respectfully submitted that Examiner has not made a prima facie case of obviousness and that rejection of Claim 14 should be withdrawn.

Regarding Claim 29, Applicant states on page 17 of the specification, in reference to FIG. 1, *"Roof 102 is shown sheathed with shingles 104 having a tapered cross sectional profile...The preferred extended length of face 107 permits slope determination tool 100 to simultaneously rest over a number of shingles 104, thereby preferably permitting slope determination tool 100 to closely conform to the slope of the underlying substrate, as show"*. Applicant's preference for face 107 comprising a length of about 24 inches is important to the function of Applicant's device, as stated above. It is clearly improper for Examiner to reject Claim 29 due to a lack of criticality based on size. In addition, it is well known within the art of pipeline branch layout work, that pipes generally comprise essentially smooth, unitary, exterior shapes. As such, it would not have been obvious to one of ordinary skill in the art to alter Bateman to span an irregular surface or closely conform to the slope of an underlying substrate. Since Examiner offers no additional basis for the rejection of Claim 29, Applicant respectfully submits that Examiner has not made a prima facie case of obviousness and that rejection of Claim 29 should be withdrawn. Furthermore, Claim 29 depends from Claim 2 (Claim 27 and Claim 26). Applicant believes Claim 2 should be allowable and therefore Claim 29 should be allowable.

Regarding Claim 32, Claim 32 depends from Claim 2 (Claim 31 and Claim 26). Applicant believes Claim 2 should be allowable and therefore Claim 32 should be allowable.

Regarding Claim 33, Claim 33 depends from Claim 2 (Claim 31 and Claim 26). Applicant believes Claim 2 should be allowable and therefore Claim 33 should be allowable.

Regarding Claim 35, Applicant repeats in full at this point by reference the entire above argument regarding amended Claim 1 and Claim 2 with specific regard to Examiner's rejection of Applicant's original Claim 8. Bateman does not provide a teaching or suggestion as to the relocating of scale (62) and/or scale (64) to disk (44) and/or disk (46). It is therefore respectfully submitted that Examiner has not made a prima facie case of obviousness and that rejection of Claim 35 should be withdrawn.

Regarding Claim 37, Applicant repeats in full at this point by reference the entire above arguments to Claim 4 regarding Applicant's preferred scale size to improve accuracy. Applicant again submits that such a limitation is non-obvious, and that there has not been presented a prima facie case of obviousness. It is therefore respectfully submitted that rejection of Claim 37 should be withdrawn.

Regarding Claim 40, Applicant repeats in full at this point by reference the entire above argument regarding Claim 29 and Applicant's length preference to permit measurement of pitch over an irregular surface (such as shingles of a roof). Applicant again submits that such a limitation is non-obvious, and that there has not been presented a prima facie case of obviousness. It is therefore respectfully submitted that rejection of Claim 40 should be withdrawn.

Regarding Claim 42, Applicant states on page 22 in reference to FIG. 3, "*Preferably, frame 105 comprises a second side 138 having a roof-shaped portion 140, as shown. Roof-shaped portion 140 is preferably adapted to aid the user in distinguishing the function of slope determination tool 100, as shown*". The chevron peripheral shape selected by the Applicant is especially useful in conveying the essential function of the apparatus to a user by visual and tactile means. None

of the cited references, including Bateman, teach or suggest the use of identifying indicia, other than the scale indicia, to assist the user in identifying the function of the device. Clearly, none of the cited references, including Bateman, teach or suggest a roof-shaped peripheral structure adapted to assist the user in identifying the function of the device. Furthermore, the structure and tactile function of Applicant's Roof-shaped portion **140** is distinctly different than any "... printed matter such as a logos, text, or shapes", suggested by Examiner. Applicant respectfully submits that the Examiner has not made a prima facie case of obviousness for the element of this Claim. It is therefore respectfully submitted that rejection of Claim 42 should be withdrawn.

The Examiner has rejected Claim 24 under 35 USC §103, as allegedly being unpatentable over Bateman (US 2,847,765) in view of Eltag (US 1,597,960)

Regarding Claim 24, Applicant's device has a different arrangement and works in a different way than does the Eltag device. Furthermore, Claim 24 depends from Claim 2 (Claim 23). Applicant believes Claim 2 should be allowable and therefore Claim 24 should be allowable.

The Examiner has rejected Claim 25 and Claim 30 under 35 USC §103, as allegedly being unpatentable over Bateman (US 2,847,765) in view of Webb (US 5,519,942)

Regarding Examiner's obviousness rejection to Claim 25 and Claim 30, as amended, Webb **does not** show at least one abutter comprising at least one laser pointer or wherein said at least one abutter comprises at least one laser pointer structured and arranged to visually extend at least one longitudinal axis of said at least one abutter. Nor is there any **teaching or suggestion** in the Bateman reference, the Webb reference, or elsewhere, to use the laser assembly of the Webb reference with the Bateman reference. In fact, **if** the laser located in the frame of the Webb reference were combined with the Bateman reference, the resulting combination would in no way produce Applicant's device. Bateman consists of the planar edges (12) and (14), generally corresponding to flat surfaces (14) and (15) of Webb. The Webb laser (42) is centrally located within frame (10), **between** planar edges (12) and (14). Thus, the laser beam projected by Webb **cannot** project in coincidence within the surface plane of, either planar edge (12) or (14),

regardless of rotation of module (25). In contrast, Applicants laser placement "*will emit laser beam 193 that is parallel to and aligned with the flat planar "level" portion 214 of first side 136*" (page 36, last paragraph). Furthermore, if the laser apparatus of the Webb reference were combined with the Bateman reference, it is clear that Bateman would not function properly as use of the center punch function would be hindered.

Applicant submits that any such combination is not obvious, and that there has not been presented a prima facie case of obviousness. It is therefore respectfully submitted that rejection of Claim 25 and Claim 30 should be withdrawn.

Applicant believes that all Claims, as amended, are allowable with respect to 35 USC §103, and respectfully request that all such rejections be withdrawn.

For the reasons given above, and after careful review of all the cited references, Applicant respectfully submits that none of the cited references nor any combination of the cited references will result in Applicant's claimed invention in the present Claims, as amended. But even if any such combination might arguably result in such claimed invention, it is submitted that such combination would be non-obvious and patentable.

If there are any fees incurred by this Amendment Letter, please deduct them from our Deposit Account NO. 50-1887.

Applicant also respectfully requests (not as a matter of form but as a special request in this case) that the Examiner, after having an opportunity to review this paper, grant a telephonic interview to Applicant's undersigned Attorney in order to discuss the application, the office action and this paper, to attempt to place this application in condition for allowance. Applicant's Attorney will contact the Examiner to collaborate on scheduling an appropriate time.

Respectfully submitted,

Date: February 21, 2005



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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence is being transmitted, via facsimile, to the Patent and Trademark Office fax number (703)-872-9306 on February 21, 2005.

Date 2/21/05

Signature: 

Martin L. Stoneman, Attorney for Appl.